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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,095	07/06/2001	Tomonori Hamada	1602-0173P	2746

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/899,095

Applicant(s)

HAMADA ET AL.

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/16/03 + 8/18/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,7,9,11,12,16-19,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,7,9,11,12,16-19,21 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 2/4/03 + 7/16/03 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1 + 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on February 4, 2003 and July 16, 2003 have been approved.

Claim Objections

Claim 4 is objected to because it fails to end with a period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1, 2, 4, 6, 7, 9, 11, 12, 16-19, 21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "each one of the lip portion extending from opposite sides" on lines 4-5 of claim 1 render the claims indefinite because they are grammatically awkward and confusing and because it is unclear how each lip portion can extend from both sides of the door glass run body. Recitations such as "edge" on line 5 of claim 1 render the claims indefinite because it is unclear how the door glass run body has one edge. It appears that the door glass run body has two opening edges. Recitations such as "when other lip portion" on lines 7-8 of claim 1 render the claims indefinite because they are grammatically awkward and confusing. Recitations such as "is bottomed" on line 8 of claim 1 render the claims indefinite because it is unclear what the applicant is attempting to set forth. What situation comprises "bottomed"? Recitations such as "the

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one lip portion . . . with said door glass run body” on lines 10-11 of claim 1 are confusing since it appears that each of the lip portions is always in contact with the door glass run body because one end of the lip portions is always connected to the door glass run body. Recitations such as “compared to said protrusion and said lip portion contact with each other” on lines 16-17 of claim 2 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Recitations such as “an inner wall face” on line 2 of claim 6 render the claims indefinite because it is unclear what element includes the inner wall face the applicant is referring to. Recitations such as “means” on line 10 of claim 16 render the claims indefinite because it is unclear whether or not the applicant is invoking 35 USC 112, 6th paragraph because the applicant has set forth the structure, i.e., the one lip portion having a set length, for performing the function set forth on lines 10-11 of claim 16.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Dupuy et al. Dupuy et al. discloses a door glass run attached to a door sash 14 of a vehicle for sealing between the door sash and a door glass 12 comprising a door glass run body 10 having a substantially U shaped cross section, a pair of lip portions 50 and

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42 with each lip portion extending from opposite sides of an opening edge of the door glass run body toward a bottom face portion 34 of the door glass run body and slidably contacting with the door glass, one lip portion of the pair of lip portions having a length set so that, when the other lip portion of the pair of lip portions is bottomed with the door glass run body, the one lip portion may not be spaced away from the door glass, and the other lip portion has a length set so that when the one lip portion is brought into contact with the door glass run body, the other lip portion may not be spaced away from the door glass (see column 3, lines 67-68 and column 4, lines 20-23), each of the lip portions has a concave notch portion (not numbered, but best seen in figure 3).

Claims 2, 4, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Keys. Keys discloses a door glass run attached to a door sash of a vehicle (not numbered, but seen in figure 1) for sealing between the door sash and a door glass 14 comprising a door glass run body 10 having a substantially U shaped cross section and a pair of lip portions 28 and 48 with each lip portion extending from opposite sides of an opening edge of the door glass run body toward a bottom face portion 16 of the door glass run body and slidably contacting with the door glass, a protrusion 29 being provided on an inner wall face of the door glass run body in an opposing relationship to a rear face of at least one of the lip portions 28 and point contacting with the at least one of the lip portions, the protrusion having a height set so that, even if the door glass vibrates, an end portion of the one of the lip portions does not contact with the door glass run body, a notch portion (not numbered, but seen in figure 7) is formed between

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a base end portion of the lip portion 28 and the inner wall face of the door glass run body.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keys as applied to claims 1, 6, 16 and 17 above. Dupuy et al. is silent concerning the particular depth of the notch portion.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the notch portions of Dupuy et al. with a depth equal to or less than 0.5 mm to ensure the proper flexibility of the lip portion.

Claims 12, 19, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keys as applied to claims 2, 4, 7 and 9 above. Keys is silent concerning the particular dept of the notch portion.

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However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the notch portion of Keys with a depth equal to or less than 0.5 mm or a depth equal to 5 mm to ensure the proper flexibility of the lip portion.

Response to Arguments

Applicant's arguments filed July 16, 2003 have been fully considered but they are not persuasive. The applicant's comments concerning 1 and 6 are moot in view of the new grounds of rejection. The applicant's comment concerning the rejection of claim 2 in view of Keys are not persuasive because claim 2 does not set forth that when each of the lip portions engages the door glass run body the other lip portion remains in contact with the door glass.

Conclusion

THIS ACTION IS NOT MADE FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a long horizontal flourish extending to the right.

Gregory J. Strimbu

Primary Examiner

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September 4, 2003